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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/384,678	08/27/1999	ALAN SLATER	CITI0095-US	8149
27510	7590	05/19/2004	EXAMINER	
KILPATRICK STOCKTON LLP 607 14TH STREET, N.W. SUITE 900 WASHINGTON, DC 20005			CUFF, MICHAEL A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 05/19/2004

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 18

Application Number: 09/384,678  
Filing Date: August 27, 1999  
Appellant(s): SLATER, ALAN

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John Harrington  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/20/04.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because applicant's use of alternative language renders claim 49 substantially the same as claim 1. Since claims 49 and 50 stand or fall together and claims 1 and 49 are substantially the same, claims 1-50 stand or fall together. The arguments are grouped together, too.

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5036461	Elliot et al.	7-1991
5455407	Rosen	10-1995

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-50 are rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office Action, Paper No. 13.

**(11) Response to Argument**

For the sake of clarity the examiner has mapped out claim 1 on the next page. Only the Elliott et al. reference will be discussed.

Also for the sake of clarity, the following appears to be sources of miscommunication. A phone call was made on 3/24/04 to John Harrington to discuss claim interpretation and to encourage applicant to continue prosecution.

Note that the Elliott et al. microprocessor 18 is being considered the service provider.

Note that, in the Elliott et al. reference, a third party credit card company may be the "intended recipient". This eliminates the need to meet the alternative limitations in claim 49, which recites two alternative conditions "if the merchant's bank is the intended recipient, ..." and "if the customer's bank is the intended recipient, ...".

Note that, a normal credit card transaction is an "electronic payment order".

Mapping of claim 1 in reference to the Elliott et al. reference.

Receiving information about the financial transaction by the service provider for the merchant	device 10 is a transaction device (receiving transaction info is inherent) microprocessor 18 is the service provider.
automatically identifying an intended recipient of the information by the service provider for the merchant; and	generating first data signals corresponding to identification data stored on the personal identification devices.  second data signals corresponding to data stored on the program modules (card issuers, intended recipients)  Column 2, lines 49-50 and 44-46
Automatically sending the information to the intended recipient by the service provider for the merchant.	a transaction program for carrying out transactions with personal identification device having a device microprocessor, and wherein the module program is arranged to executed (sending) by the module microprocessor (service provider). Column 2, lines 53-58

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Appellant asserts that Elliott et al. does not show a service provider. The Examiner does not concur. See above arguments about miscommunications. All further arguments are based on if microprocessor 18 can be considered a "service provider.

As for claim 49, the issues of electronic payment order and alternative language are discussed above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

*Michael Cuff 5/17/04*  
Michael Cuff  
May 17, 2004

Conferees  
John Weiss  
Bob Olszewski

*[Signature]*  
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